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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,023	02/18/2004	Thomas A. Findley	NE1.008	5413
23893	7590	11/04/2005	EXAMINER	
TIMOTHY E SIEGEL 1868 KNAPPS ALLEY SUITE 206 WEST LINN, OR 97068			ROSEN, NICHOLAS D	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 11/04/2005

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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/782,023  
Filing Date: February 18, 2004  
Appellant(s): FINDLEY, THOMAS A.

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Timothy E. Siegel  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed October 6, 2005 appealing from the  
Office action mailed October 21, 2004.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,862,220	Perlman	01-1999
6,095,413	Tetro et al.	08-2000

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetro et al. (U.S. Patent 6,095,413) in view of Perlman (U.S. Patent 5,862,220). As per claim 1, Tetro discloses a method for partially verifying the legitimacy of a remote purchase request based on a card number from a card issuing financial institution comprising (a) receiving and storing a first purchase request information set including a card number and address information (column 2, line 63, through column 3, line 11); and (b) sending said card number and address information to said card issuing financial institution to

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determine if said address information matches an address on file for said card number at said card issuing financial institution (column 3, lines 19-23; column 4, line 60, through column 5, line 18). Tetro discloses receiving and storing an electronic origin (column 3, lines 38-46; column 7, lines 39-61), but Tetro does not disclose sending the electronic origin to the card issuing financial institution to determine if the electronic origin matches an origin on file for the card number at said card issuing financial institution. However, Perlman teaches determining if the electronic origin of a would-be purchaser matches an origin expected for the corresponding card number (column 13, lines 26-49). Hence, it would have been obvious to one of ordinary skill in the art of business at the time of applicant's invention to send the electronic origin to the card issuing financial institution to determine if the electronic origin matched an origin on file for the card number at said card issuing financial institution, for the advantage, as stated by Perlman, of preventing fraudulent purchases.

As per claim 2, Perlman does not expressly teach receiving an indication of whether or not said electronic origin did match said electronic origin on file for said card number at said card issuing financial institution, but does teach that a credit card transaction is authorized or denied based on whether the electronic origin did match the expected origin, which would have to be on file to be expected (column 13, lines 26-49), from which it is inherent that an indication would have to be received.

As per claim 3, Perlman does not expressly teach said financial institution comparing said electronic origin to a file of origins associated to said card number, but does teach deciding whether to accept or reject a transaction based on whether the

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electronic origin corresponds to the expected electronic origin (column 13, lines 26-49), from which it is inherent that at least one origin associated to the card number would have to be on file.

#### **(10) Response to Argument**

Appellant's arguments depend in part on the failure of the prior art of record to accomplish things which are nowhere recited in the claims, nor necessarily connected to the actual claim limitations. As set forth in the rejections above, the Tetro and Perlman patents make Appellant's actual claims obvious, and it is not proper to allow claims based on any failure of the prior art of record to disclose features which are nowhere recited as claim limitations. If Appellant believes that the features on which he bases his arguments provide a basis for patentability, the reasonable and proper course of action would be to amend the claims to recite those features as limitations, which Appellant has not done. (It may be noted that two parent cases have issued as U.S. patents, 6,108,642 and 6,714,919, based on specific limitations not set forth in the present set of claims.)

Appellant argues that neither Tetro nor Perlman suggests determining whether an electronic origin is associated with a credit card number, despite Perlman's teaching of associating the electronic origin with the expected ANI of a "customer box." (Perlman actually uses the words "client box" in column 13, lines 26-49.) Examiner replies that Perlman teaches determining if the electronic origin of a would-be purchaser matches an origin expected for the corresponding card number, as may readily be confirmed

from the indicated section of column 13 in Perlman. Examiner maintains that the validity and relevance of Perlman's teaching is in no way abolished by the fact that Perlman's client box is a physical box electrically associated with a television set, etc. The television set in question is connected through the Internet, and used for Web TV, including catalog browsing, etc., but when the user attempts to make a credit card purchase, the server makes sure that the ANI corresponds to the expected telephone number of the client box. The ANI (automatic number identification) corresponds to a telephone number, and the telephone network is electronic; therefore, the ANI corresponds to an electronic origin.

Appellant argues that this feature of Perlman is completely different from the action of a purchase request-receiving party sending an origin to a financial institution, together with a credit card number. Examiner replies that Perlman was not relied upon for sending an origin and a credit card number to a financial institution; Tetro, the primary reference, discloses sending a card number and address information to the card issuing financial institution to determine if the address information matches an address on file for the card number at the card issuing financial institution (column 3, lines 19-23; column 4, line 60, through column 5, line 18). The address information in Tetro is a billing address, not an electronic origin (although Tetro further discloses preventing attempted purchases from blocked electronic origins; see column 7, lines 39-61), and it is for the teaching of comparing an electronic origin to a particular expected electronic origin for a corresponding credit card number (or other personal or confidential information) that Perlman is relied upon.

Next, Appellant argues that neither Tetro nor Perlman suggest the method of claim 1, because the rationale for checking the ANI (caller ID) is not suggested in those patents. Appellant states that the reason for associating the ANI with the credit card number in his invention serves a more subtle purpose than in Tetro or Perlman, namely, providing a reassurance in an otherwise doubtful case that the card is being used by the card owner, who may lawfully be making a purchase from a telephone other than his own. Examiner replies that the claims say nothing about a subtle purpose, reassurance in doubtful cases, or a card owner lawfully making a purchase from a telephone other than his own. Even if, *ad arguendo*, these might perhaps be grounds for allowance if they were claim limitations, they are not claim limitations, and therefore cannot be grounds for allowing the claims as they currently stand.

Next, on page 5 of the Appeal Brief, Appellant argues that in Perlman, the purchase is made by the use of a credit card, which would not be necessary if the client box of Perlman replaced the function of a credit card, and concludes that the only fraud Perlman's method would prevent is that caused by a change in location of the client box from one telephone line to another, e.g., by theft of the box. Examiner notes that Perlman expressly teaches that his method can prevent another kind of fraud, that occurring when a hacker attempts to forge a transaction from a pay telephone (column 13, lines 40-43), but that is a minor point.

Appellant argues that even combining the systems of Tetro and Perlman, a thief could use the Perlman box connected to Perlman's system, and a stolen credit card to buy an item from a merchant without the merchant being notified that the electronic



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origin of the purchase request did not match any electronic origin associated with the credit card used. Examiner replies that very much the same thing could happen with Appellant's invention as claimed, which merely determines whether the electronic origin matches an electronic origin on file for a card number, but provides no remedy for preventing fraud by someone who has stolen both the card number and unauthorized access from the corresponding electronic origin. Likewise, Appellant's subsequent scenarios of how a merchant might decline a legitimate purchase request because he had no reassurance that a thief had not gained access to the client box, or how an enterprising thief might sign up for WebTV with a false name and make purchases with stolen credit cards do not make Appellant's claims patentable, because the claims recite no features that would necessarily prevent these scenarios from occurring. If Appellant has invented a method for assuring that such problems cannot occur, and described the method in his specification, let him specify the method in his claims, so that it will be possible to determine precisely what is claimed, and compare the claim elements to the prior art.

Finally, on page 6, Appellant argues that although the Perlman method requires a box connected to a telephone line and some other remote access network, the method of the present invention is applicable to any credit or debit card remote purchase made via the Internet or telephone line, without any great complication. Examiner replies that this may perhaps be true, but Appellant's pending claims nowhere so much as use the words "Internet" or "telephone". Even supposing that some embodiments of the claimed invention might clearly distinguish over the combination of

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Tetro and Perlman, the claims cannot be allowed on the grounds that some embodiments might differ from the prior art, but can only be allowed if they actually recite elements which do differ from the prior art.

In conclusion, the claims as they stand are overly broad, and do not distinguish over the combination of Tetro and Perlman.

**(11) Related Proceeding(s) Appendix**

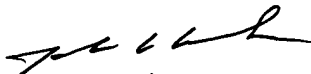
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

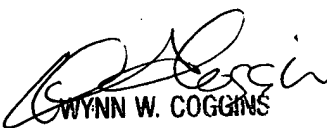
Respectfully submitted,

*Nicholas D. Rosen*      *October 25, 2005*  
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